

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KLAUS-PETER POERSCHMANN

Appeal No. 2000-0510
Application No. 08/792,966

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, COHEN and JENNIFER D. BAHR,
Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4,
which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to a chassis for commercial vehicles in which a low floor is required. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Cilley	1,251,749	Jan. 1, 1918
Anglada (Anglada '405)	1,481,405	Jan. 22, 1924
Anglada (Anglada '044)	1,543,044	Jun. 23, 1925
Hawkins	4,807,716	Feb. 28, 1989

The following rejections are before us for review.

- (1) Claims 1 through 4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.
- (2) Claims 1 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anglada '405 in view of Hawkins.
- (3) Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anglada '044 in view of Hawkins.
- (4) Claims 1, 2 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anglada '405 in view of Cilley.

Reference is made to the brief (Paper No. 11) and the answer (Paper No. 12) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims¹, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. See In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

The examiner's basis for determining that the claims are indefinite, as set forth on page 3 of the answer, is as follows:

In claim 1, the recitations "the housing of one of the drive motors and the housing of a corresponding gear drive are joined nonpositively to one another" and "the housings of the gear drives are mounted nonpositively to the portal axle" are vague and unclear because their meaning could be interpreted in

¹ Consistent with the guidelines set forth on page 4, in lines 22-25, of the appellant's specification (see Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984)), we interpret the terminology "substantially at a right angle" in claim 1 as requiring that the motor be arranged at close enough to a perfect right angle relative to the axle to permit a low-floor portion to extend on the same level as the low-floor portion in the door area over an acceptable width as determined by one skilled in the art of designing commercial vehicles.

many different ways. The term "nonpositively" is unclear as to the specific type of connection therebetween.

The term "positive" has several different interpretations, including formally or arbitrarily set, definitely set, admitting of no modification, precise, specific, affirmative, certain, tending in the direction regarded as that of increase, progress, etc.,² depending on the particular context in which it is used. The term "nonpositively," without further clarification, likewise could take on any one of several meanings, such as variable (admitting of modification), imprecise, uncertain or negative, for example.

Keeping in mind that the definiteness of language employed must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art (see In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971)), we turn to the appellant's underlying disclosure to determine whether it provides any guidance as to the meaning of "nonpositively" in the context of the appellant's invention. The appellant's specification, on page 4, informs us that

[e]ach drive motor is nonpositively joined by its housing 31 to housing 71 of its gear drive 7. In addition, housings 71 of both gear drives 7 are nonpositively mounted on portal axle 1.

The sole drawing in the appellant's application does not illustrate any connection between the motor housing 31 and the gear drive housing 71. Further, the illustration of the

² Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

gear drive housings 71 in relation to the axle 1 is of such a nature that the existence or details of any connection between the gear drive housings and the axle cannot be ascertained from the drawing.

In light of the foregoing, we conclude that one of ordinary skill in the art would not be able to determine the meaning of "nonpositively" as used in claim 1 and, thus, would not be able to ascertain the metes and bounds of the claimed invention. Moreover, we share the examiner's opinion (answer, page 7) that the appellant's arguments on page 3 of the brief fail to provide a clarification of the claim terminology "joined nonpositively" and "mounted nonpositively." The fact that the priority document uses the German word "Kraftschlussig," which, according to the appellant, translates as "frictionally interconnected, tensionally force locked, nonpositively," sheds no light on the interpretation of "nonpositively" as used in the appellant's specification and claims. Specifically, a claim under 35 U.S.C. § 119 for priority of an earlier application filed in a foreign country is not alone an express or implied incorporation-by-reference of the priority application³ and does not imply that the application in which the priority claim is made is a true translation of the priority application.⁴ Moreover,

³ See Ex parte Bondiou, 132 USPQ 356, 358 (Bd. Pat. App. 1961)(a claim to a foreign application under 35 U.S.C. § 119 does not *per se* permit the introduction of subject matter from the foreign application into the application containing such claim).

⁴ Section 119 does not require that an application be a true translation of the foreign application for which priority is claimed, or that an application include all (or even a substantial portion) of the subject matter of the foreign application for which priority is claimed. Section 119 simply provides, subject to the satisfaction of the conditions set forth therein, the benefit of the filing date of such foreign application as to the subject matter disclosed, in the manner provided by the first paragraph of section 112, in such foreign application.

even accepting the appellant's definition of "Kraftschlussig," the appellant's attempt to use a term which has as one of its meanings or as part of its meaning the term "nonpositively" to define the term "nonpositively" is of no avail. The appellant's contention that, in the simplest of terms, what "nonpositively" means in the context of the present invention is that "the corresponding two parts are securely joined directly to one another (although in a preferred embodiment, they may be releasably joined together, e.g., by means of a bolted connection)" is simply not supported by the original disclosure of the application and is not implied even by the definition of "Kraftschlussig" proffered by the appellant.

Accordingly, we shall sustain the examiner's rejection of claims 1 through 4 under 35 U.S.C. § 112, second paragraph, as being indefinite.

The obviousness rejections

We emphasize again here that claim 1 contains unclear language ("nonpositively") which renders the subject matter thereof indefinite for the reasons stated *supra*. We find that it is not possible to apply the prior art to claims 1 through 4 in deciding the issues of obviousness under 35 U.S.C. § 103 without resorting to speculation and conjecture as to the meaning of the questioned terminology in claim 1.⁵ This being the case, we are therefore constrained to reverse the examiner's rejections of claims 1 through 4 under 35 U.S.C. § 103 in light of the holding in In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). We hasten to

⁵ This is highlighted by the nature of the appellant's arguments on pages 3-5 of the brief with regard to the distinctions between the applied prior art and the claimed subject matter.

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add that this reversal of the examiner's rejection is based only on the procedural ground relating to the indefiniteness of these claims and therefore is not a reversal based on the merits of the rejections under 35 U.S.C. § 103.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 4 under 35 U.S.C. § 112, second paragraph, is affirmed and the examiner's decision to reject claims 1 through 4 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

HARRISON E. McCANDLISH
Senior Administrative Patent Judge

IRWIN CHARLES COHEN
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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